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Paul J. Flanningan

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PAUL J. FLANNIGAN and STEVEN J. MAXA

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Appeal 2009-007085  
Application 10/719,959  
Technology Center 3700

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Decided:<sup>1</sup> July 29, 2009

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Before DEMETRA J. MILLS, ERIC GRIMES, and LORA M. GREEN,  
*Administrative Patent Judges.*

GRIMES, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a  
respiratory mask and a method of making a face piece insert for a respiratory

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

mask. The Examiner has rejected the claims as anticipated and obvious. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

## STATEMENT OF THE CASE

The Specification discloses “a method of making a facepiece insert where the fluid communication components and the portion of the insert that carries those components are separately manufactured and are subsequently secured together to form the insert” (Spec. 1: 6-9).

Figure 1 of the Specification is shown below:

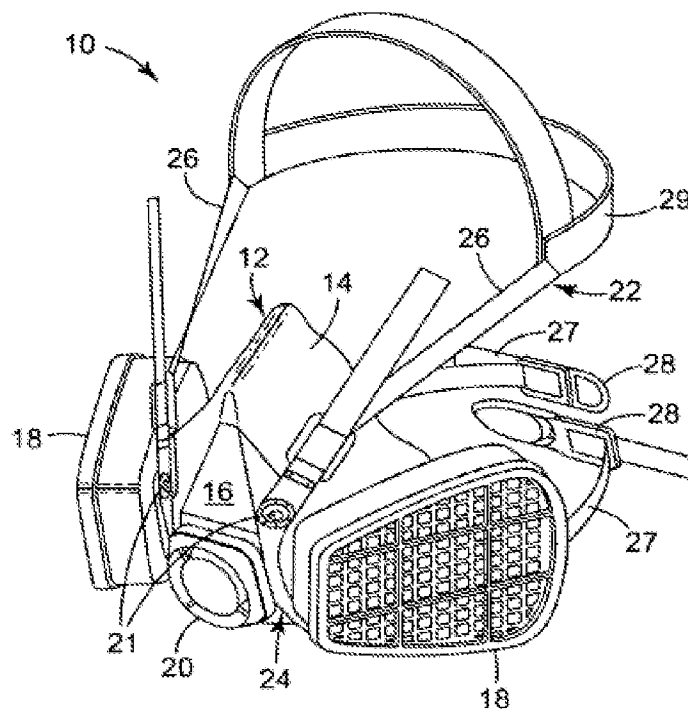


FIG. 1

Figure 1 “shows a respiratory mask 10 that has a mask body 12 that has a compliant face contacting member 14 secured thereabout. ... A rigid facepiece insert 16 is disposed centrally in the mask body 12 to provide

structural integrity to the mask so that it can properly support filter cartridges 18.” (*Id.* at 4: 27 to 5: 3.)

Figure 3 of the specification is shown below:

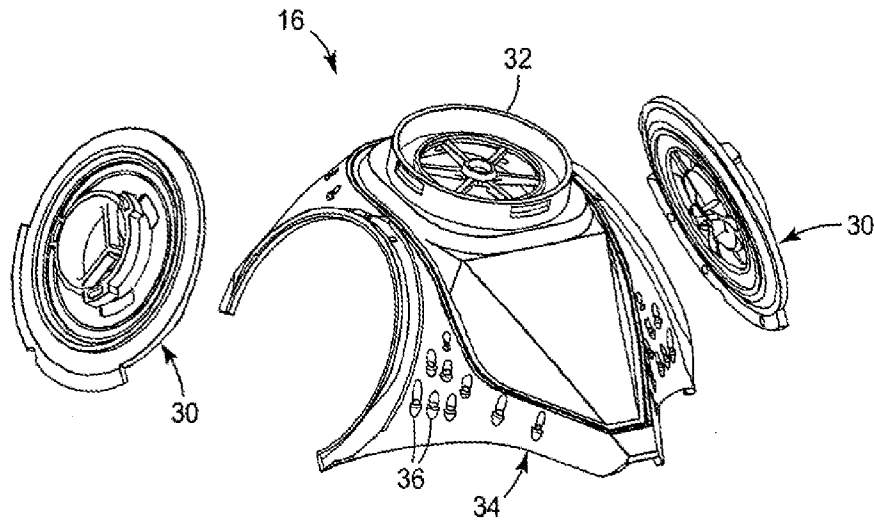


Figure 3 shows “a perspective of a facepiece insert 16, showing the fluid communication components 30 separate from the supporting portion 34” (*id.* at 4: 11-14).

Claims 1-26 are pending and on appeal. Claim 1 is representative and reads as follows:

Claim 1: A method of making a facepiece insert that has at least one fluid communication component, which method comprises:

- (a) providing at least one supporting portion of a facepiece insert;
- (b) providing at least one fluid communication component separately from the supporting portion of the facepiece insert; and
- (c) securing the at least one fluid communication component to the at least one supporting portion.

The claims stand rejected as follows:

- claims 1-4, 13, 14, 16-19, and 21-26 under 35 U.S.C. § 102(b) in view of Scholey;<sup>2</sup> and
- claims 5-12, 15, and 20 under 35 U.S.C. § 103(a) in view of Scholey.

## ANTICIPATION

### *Issue*

The Examiner has rejected claims 1-4, 13, 14, 16-19, and 21-26 under 35 U.S.C. § 102(b) as anticipated by Scholey. The Examiner finds that

Scholey teaches a respirator mask with snap in filter cartridge that comprises providing at least one supporting portion 22 of a face-piece insert 12 ... ; providing at least one fluid communication component 24 (see figure 1A) separately from the supporting portion of the face-piece insert; and securing the at least one fluid communication component to the at least one supporting portion.

(Answer 3.)

Appellants contend that the Examiner erred in finding that Scholey discloses “providing at least one fluid communication component,” as recited in claim 1 (Appeal Br. 8-11).

The issue with respect to this rejection is: Does the evidence of record support the Examiner’s finding that Scholey discloses a step of “providing at least one fluid communication component?”

### *Findings of Fact*

1. The Specification recites that “‘fluid communication component’ means an element *that is not part of a filter cartridge and* that is structured

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<sup>2</sup> Scholey et al., US 6,298,849 B1, Oct. 9, 2001

to allow a fluid to pass from an interior gas space to an exterior gas space or vice versa” (Spec. 3, as amended June 5, 2007; emphasis added to language added by amendment).

2. Scholey discloses a respirator mask that “includes replaceable cartridges” (Scholey, col. 1, ll. 6-8).

3. Scholey’s Figure 1 is shown below:

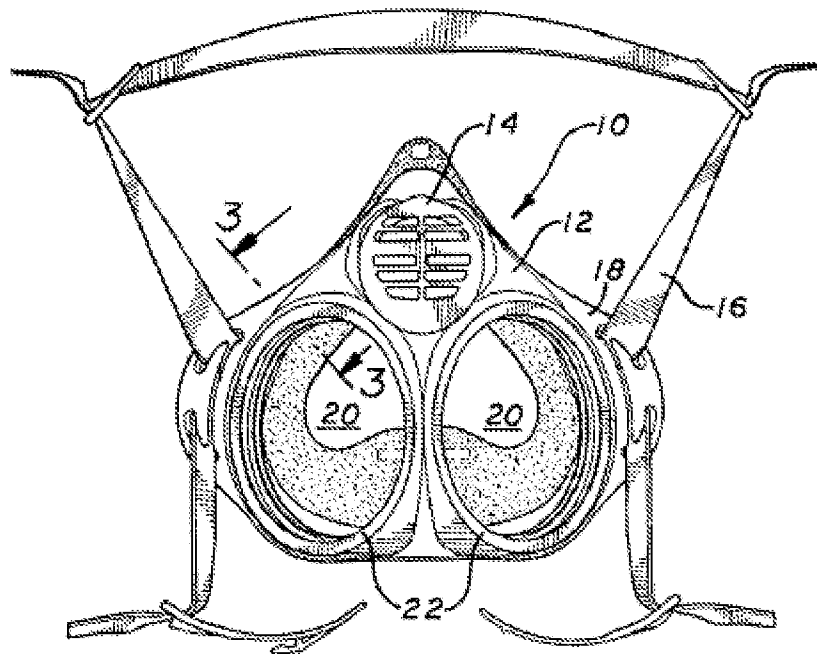
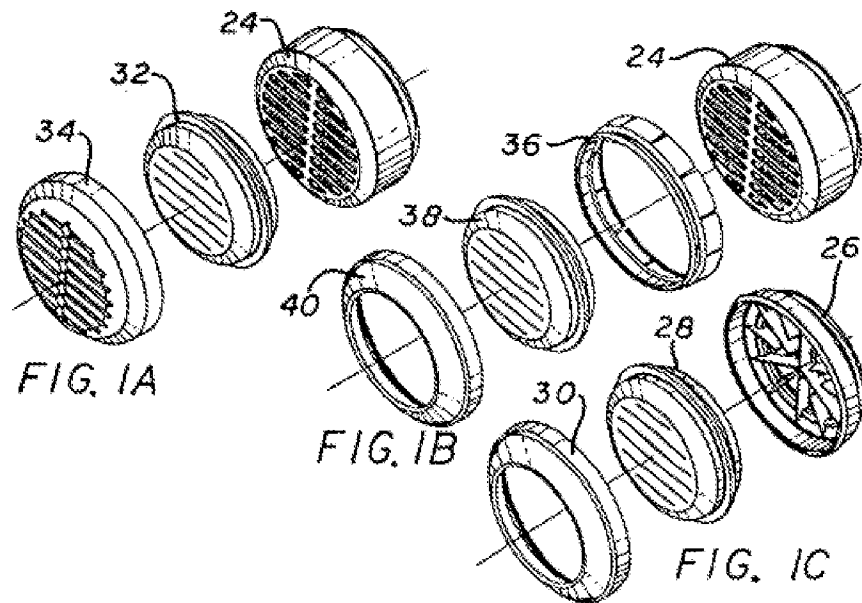


Figure 1 shows a front elevational view of a respirator mask (*id.* at col. 2, l. 24). Scholey discloses that the “mask body 12 also includes a pair of cartridge openings 20” (*id.* at col. 2, ll. 48-49).

4. Scholey’s Figures 1A, 1B, and 1C are reproduced below:



The figures show “exploded views of a plurality of filter cartridges or cartridge assemblies that can be used with the mask of FIG. 1” (*id.* at col. 2, ll. 26-28).

5. Scholey discloses that

[a]s shown in FIGS. 1A, 1B and 1C, individual filter cartridges 24 may be positioned within the openings 20 or cartridge assembly members 26 (one of which is shown in FIG. 1C) may be positioned within the cartridge openings 20. The filter cartridges 24 are complete cartridges in themselves, whereas the filter assembly members 26 requires additional members such as a replaceable filter member 28 and a cover member 30 to form a total filter assembly.

In addition, as shown in FIGS. 1A and 1B other types of additional filter members may be placed over the filter cartridge 24 such as a filter cartridge 32 and a cover member 34 to provide additional filter capacity or a coupling member 36 followed by a cartridge 38 and cover member 40 to again provide additional filtering capability to the cartridge 24.

(*Id.* at col. 2, ll. 52-66.)

*Principles of Law*

“To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.” *PPG Indus. Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996).

[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.

*In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

“Although words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

“The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.” *Id.*

*Analysis*

Claim 1 is directed to a method of making a facepiece insert comprising, among other steps, providing a “fluid communication component separately from the supporting portion of the facepiece insert” and securing the two to each other.



The Examiner reasons that the “filter cartridge 24 of ... Scholey is defined as the fluid communication component and is [provided] separately from the supporting portion 22 of the face piece insert 12” (Answer 7).

Appellants argue that the definition of “fluid communication component” in the Specification was amended “to clearly specify that it is not part of a filter cartridge” and that the Specification clearly identifies “a filter cartridge as being a part separate from the fluid communication component” (Appeal Br. 10). Thus, Appellants argue that “[b]ecause Scholey’s parts 24 and 26 are clearly parts of the filter cartridge, ... they do not qualify as a fluid communication component as defined in the present application” (*id.*).

Appellants’ arguments are persuasive. Although the Examiner objected to Appellants’ amendment to the Specification (Answer 6), Appellants petitioned to have the Examiner’s objection reversed (Petition under 37 C.F.R. § 1.181, filed July 11, 2008). Appellants’ petition was granted (Petition Decision mailed Aug. 18, 2008). Thus, the Specification has been amended to expressly define a “fluid communication component” as an element that is not part of a filter cartridge.

The Examiner identifies filter cartridge 24 of Scholey as corresponding to the claimed fluid communication component. The Specification, however, defines a fluid communication component as an element that is not a part of a filter cartridge. The Examiner has not adequately shown that Scholey discloses a fluid communication component as defined by the Specification.

Independent claims 13 and 22 are directed to products but also require a “fluid communication component.” The rejection of claims 13 and 22 is also reversed for the reasons discussed above, as is the rejection of claims 2-4, 14, 16-19, 21, and 23-26, which depend from one of claims 1, 13 or 22.

*Conclusion of Law*

The evidence of record does not support the Examiner’s finding that Scholey discloses a “fluid communication component.”

**OBVIOUSNESS**

The Examiner has rejected claims 5-12, 15, and 20 under 35 U.S.C. § 103(a) as obvious in view of Scholey. The Examiner relies on Scholey as discussed above, and further finds that Scholey suggests dependent claim limitations for claims 5-12, 15, and 20 (Appeal Br. 5-6).

As discussed above, however, the Examiner has not adequately explained how Scholey discloses a “fluid communication component” as that term is defined in the Specification. Nor has the Examiner explained why such a “fluid communication component” would have been obvious based on Scholey. The rejection of claims 5-12, 15, and 20 as obvious in view of Scholey is reversed.

**SUMMARY**

We reverse the rejection claims 1-4, 13, 14, 16-19, and 21-26 under 35 U.S.C. § 102(b) as anticipated by Scholey, and the rejection of claims 5-12, 15, and 20 under 35 U.S.C. § 103(a) as obvious in view of Scholey.

**REVERSED**

Appeal 2009-007085  
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